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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,337	02/27/2002	Henry Yue	PF-0742 USN	2453

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INCYTE CORPORATION
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EXAMINER

SAIDHA, TEKCHAND

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,337

Applicant(s)

YUE ET AL.

Examiner

Tekchand Saidha

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Group 1 (all in-part), claim(s) 1-2 & 16-17, drawn to polypeptide of SEQ ID NO: 1 [phosphatase] and composition thereof.

Groups 2-11 (all in-part), claim(s) 1-2 & 16-17, drawn to polypeptide of SEQ ID NOS: 2-11, an composition thereof [The groups have been put together for convenience].

Group 12 (all in-part), claim(s) 3-9 & 11-12, drawn to polynucleotide [SEQ ID NO : 12] encoding polypeptide of SEQ ID NO: 1 [phosphatase] vector, host cell and method of making the polypeptide, respectively.

Groups 13-22 (all in-part), claim(s) 3-9 & 11-12, drawn to polynucleotides [SEQ ID NO : 13-22] encoding polypeptide of SEQ ID NO: 2-11 [phosphatase] vector, host cell and method of making the polypeptide, respectively.

Groups 23-33, claim(s) 10, drawn to antibody against SEQ ID NO : 1-11, respectively.

Groups 34-44, claim(s) 13-15, drawn to method of detection of polynucleotide of SEQ ID NO : 12-22, respectively.

Groups 45-55, claim(s) 18 & 27, drawn to a method of treating disease using the polypeptide of SEQ ID NO : 1-11, respectively.

Groups 56-66, claim(s) 19-24 & 26, drawn to a method of screening agonist/antagonist of the polypeptide of SEQ ID NO : 1-11, respectively.

Groups 67-77, claim(s) 25, drawn to a method of screening a compound that specifically binds to polypeptide of SEQ ID NO : 1-11, respectively.

Groups 78-88, claim(s) 28, drawn to a method of assessing toxicity of a test compound by treating a biological material with the nucleic acid sequences of SEQ ID NOS : 12-24, respectively.

3. The inventions listed as Groups 1-88 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Each of the Groups 1-11 has the special technical feature of the polypeptide sequences of SEQ ID NO : 1-

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11 (each distinct from the other), respectively, which Groups 12-88 do not share; Each of the Groups 5-8 has the special technical feature of the nucleotide sequences of SEQ ID NOS : 12-22 (each distinct from the other), respectively, host cell and a method of making the polypeptide, which Groups 1-11 & 23-88 do not share. Each of the Groups 23-33 has a special technical feature in a distinct antibody pertaining to each of the polypeptide sequences of SEQ ID NOS : 1-11, which Groups 1-22 & 34-88 do not share. Each of the Groups 35-88, employ structurally distinct nucleotide sequences of SEQ ID NOS : 12-22 or the polypeptide sequences of SEQ ID NOS : 1-11 in distinct methods, however, in view of 37 CFR 1.475(b), when claims corresponding to different categories of inventions are present then only (3) and additional methods of use are deemed to lack unity. Thus the various groups discussed above show a lack of unity of invention.

4. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

5. "A telephone restriction requirement was not made in this application due to an explicit request by Incyte and their policy of not making elections in response to telephonic restriction requirements."

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tekchand Saidha whose telephone number is (571) 272 0940. The examiner can normally be reached on 8.30 am - 5.00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on (571) 272 0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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June 8, 2004